

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 2-59 and 61-68 remain in this application. Claims 1 and 60 have been canceled. Claims 3-18, 32-39, 41-42, 44-46, and 49-68 have been withdrawn as the result of an earlier restriction requirement, and applicant retains the right to present those claims in a divisional application, although applicant notes that all of these claims depend on new claim 69, and thus should be re-introduced upon allowance of claim 69. New claims 69-71 are added without adding any new matter.

The examiner objected to claims various claims for lacking proper antecedent basis. The claims have been amended to correct this issue.

Claims 1, 2, 20, 21, 26-29, 31, 32, 40 and 47 were rejected under 35 U.S.C. §102(a) as being anticipated by Ritter (WO 99/35771). Claims 30, 43, and 48 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ritter. Claims 19 and 22-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ritter in view of Baumann (U.S. 6,104,922). For the following reasons, the rejections are respectfully traversed.

Claim 1 has been canceled, making the rejections moot. Furthermore, new claim 69 recites, *inter alia*, the steps of:

transmitting, to the user terminal, an order
parameter that is connected to the selected
offer;

and

executing, in said personal terminal, an order program with which order data can be entered, wherein at least certain order parameters are used for adapting an entry mask displayed by the order program according to the selected offer;

Ritter does not teach such steps. Instead, Ritter appears to disclose using the same entry mask regardless of the selected offer (see Fig. 3 and p. 9, lines 21-30). The fields shown in Fig. 3 appear to be pre-defined, and thus cannot be adapted according to the selected offer. Furthermore, there is no teaching in Ritter of the "order parameters" recited by the claim. Accordingly, new claim 69 is patentable over the reference. New claim 71, which recites a system for performing the method that is recited in claim 69, is thus patentable over the reference for at least the same reasons.

Baumann does not overcome the shortcomings of Ritter, and thus the remaining claims, which depend on claim 69, are thus patentable over both of the references.

Furthermore, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01). The mere fact that references can be combined or modified, alone, is not sufficient to establish prima facie obviousness (Id.). The prior art must also suggest the desirability of the combination (Id.). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (Id.).

The Examiner merely lists a generalized advantage of the combination based on a benefit of the secondary reference. This is not proper. Merely listing

an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person.” (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious “as a whole”, not as a piecemeal combination of elements from various references. Furthermore, merely listing a benefit of the secondary reference as “motivation” for modifying the primary reference is not enough, as any secondary reference has some “benefit”. The Examiner must show why one of ordinary skill would provide that particular modification to the primary reference.

Accordingly, the rejection for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn.

Finally, the Examiner has taken official notice of a number of features of dependent claims 30, 43, and 48. However, applicant disputes these assertions. Taking “official notice” requires that facts outside of the record be capable of instant and unquestionable demonstration as being ‘well-known’ in the art (see MPEP §2144.03). Instead, it appears that the Examiner has attempted, but failed, to find a reference which teaches the cited elements of the rejected claims. Hence, these elements are not likely to be “notoriously well known” as required (*id.*). Accordingly, applicant hereby traverses these taking of official notice and formally requests, as required by the MPEP (*id.*), that the Examiner

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locate a reference in support of his position that the features of claims 30, 43, and 48 are well-known in the art of the subject application. The Examiner is further reminded that it is not sufficient to merely show that features are well-known. The Examiner must also show the proper motivation for adding such features to the prior art to arrive at the claimed invention(s).

Consequently, applicant asserts that the Examiner's rejection of claims 30, 43, and 48, based on the Official notice that is herein traversed, be withdrawn absent the Examiner finding a reference supporting the notoriously "well known" nature of the claimed feature.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 34359.

Respectfully submitted,
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